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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,691

09/12/2003

Yoshiharu Kanda

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05/03/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

MOONEY, MICHAEL P

ART UNIT

PAPER NUMBER

2883

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,691

Applicant(s)

KANDA ET AL

Examiner

Michael P. Mooney

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 7*, 8, 15-18 is/are allowed.
- 6) ☒ Claim(s) 9-11, 14, 19-21 and 24 is/are rejected.
- 7) ☒ Claim(s) 12, 13*, 22, 23* is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

Figures 1-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "plural pieces of optical fiber guide sections 24" must be shown or the feature(s) canceled from the claim(s), e.g. claims 7, 13, 23. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-11, 19-21 are rejected under 35 U.S.C. 102b as being anticipated by Osaka et al. (4812010).

Osaka et al. teaches an optical fiber axial alignment device (e.g., fig. 7) for axially aligning at least one pair of opposing optical fibers composed of bare optical fibers, optical fiber strands, unit cores or plural cores of optical fiber core wires, and tape shaped optical fiber core wires, (fig. 7) the optical fiber axial alignment device comprising: a butt alignment section 17 having at least one pair of butt alignment grooves 28 (figs. 7, 8a) formed apart from one another with a given distance in an

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opposing relationship on a substantially straight line (figs. 7, 8a); and optical fiber guide sections 11, each having at least one pair of guide grooves 22 (figs. 4a, 7, 8a), being disposed on both sides of the butt alignment section (fig. 7), and being movable so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber.

The claim element "and being movable so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber" has not been given patentable weight for at least one of the three following reasons:

1) CAPABLE OF

It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

2) INTENDED USE

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987).

3) APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

>While features of an apparatus may be recited either structurally or functionally, claims < directed to > an < apparatus must be distinguished from the prior art in terms of structure rather than function. > In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

The structure of Osaka et al. at, e.g., figure 7, is capable of performing the function of "being movable so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber". Therefore, "being movable

so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber” has not been given any patentable weight in this device claim.

Thus claim 9 is met.

Osaka et al. teaches further comprising: optical fiber holder sections 3 (fig. 3), for holding at least one pair of the optical fibers, located on both sides of the optical fiber guide sections 11 (figs. 3, 7). Thus claim 10 is met.

Osaka et al. teaches wherein the optical fiber guide section 11 comprises at least one guide groove 22 placed on substantially the same extension line that connects at least one pair of the butt alignment grooves (figs. 7, 8a) formed on the butt alignment section 17 (figs. 3, 4a, 7, 8a). Thus claim 11 is met.

By the reasons and references given above each and every element of each of claims 19-21 are taught by Osaka et al. Thus claims 19-21 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 14, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaka et al. (4812010).

Osaka et al. teaches an optical fiber axial alignment device (e.g., fig. 7) for axially aligning at least one pair of opposing optical fibers composed of bare optical fibers, optical fiber strands, unit cores or plural cores of optical fiber core wires, and tape shaped optical fiber core wires, (fig. 7) the optical fiber axial alignment device comprising: a butt alignment section 17 having at least one pair of butt alignment grooves (figs. 7, 8a) formed apart from one another with a given distance in an opposing relationship on a substantially straight line (figs. 7, 8a); and optical fiber guide sections 11, each having at least one pair of guide grooves 22 (figs. 4a, 7, 8a), being disposed on both sides of the butt alignment section (fig. 7), and being movable so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber.

The claim element “and being movable so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber” has not been given patentable weight for at least one of the three following reasons:

1) CAPABLE OF

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

2) INTENDED USE

It has been held that a recitation with respect to the manner in which a claimed

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apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

3) APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

>While features of an apparatus may be recited either structurally or functionally, claims < directed to > an < apparatus must be distinguished from the prior art in terms of structure rather than function. > In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In *re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); < In *re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

The structure of Osaka et al. at, e.g., figure 7, is capable of performing the function of "being movable so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber". Therefore, "being movable so as to facilitate the optical fiber to be received in the butt alignment grooves by lifting and lowering the optical fiber" has not been given any patentable weight in this device claim.

Although Osaka et al. does not explicitly teach an image pickup means to produce a picture signal of the alignment status it would have been obvious to do so because it is conventionally known in the optical fiber alignment art to use an image pickup means to produce a picture signal of the alignment status. One of ordinary skill in the art would have been motivated to use an image pickup means to produce a picture signal of the alignment status for the purpose of providing a more conveniently-viewed image which can allow for a more accurate alignment.

Thus claim 14 is rejected.

By the reasons and references given above each and every element of claim 19 is taught by Osaka et al. (See also: the 102 rejection above).

By the reasons and references given above each and every element of claim 24 is rendered obvious under Osaka et al. Thus claim 24 is rejected.

Response to Arguments

Applicant's arguments with respect to the rejection under Imada et al. in the 10/18/05 non-final rejection have been considered and are accurate with respect to distinguishing over Imada et al. but are moot in view of the new ground(s) of rejection in the instant Office action.

Allowable Subject Matter

Claims 1-6, 7*, 8, 15-18 are allowed.

Claims 12, 13*, 22, 23* are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*As stated above in the *Drawings* section, the allowance of claims 7, 13, 23 also depends upon the submission of proper drawing(s).

The prior art, either alone or in combination, does not disclose or render obvious either the methods of aligning, the guide groove wider than the butt-alignment groove, or plural pieces of optical fiber guide sections on both sides of the butt-alignment section in combination with the rest of the respective claim 1-8, 15-18, 12-13, 22, or 23.

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It is noted that the respective claim 1-8, 15-18, 12-13, 22, or 23 is allowable because of the unique combination of each and every specific element stated in the said respective claim.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hattori (6034718), Zheng et al. (5570446) disclose optical splicing devices having image pickup means that can produce a picture signal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Mooney whose telephone number is 571-272-2422. The examiner can normally be reached during weekdays, M-F.

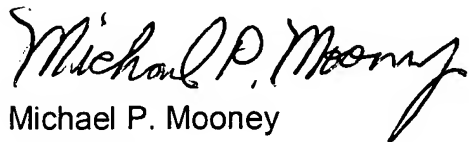
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic


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Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Michael P. Mooney". The signature is fluid and cursive, with the first name "Michael" and last name "Mooney" clearly legible.

Michael P. Mooney
Examiner
Art Unit 2883

A handwritten signature in black ink, reading "Frank G. Font". The signature is fluid and cursive, with the first name "Frank" and last name "Font" clearly legible.

Frank G. Font
Supervisory Patent Examiner
Art Unit 2883

FGF/mpm
4/26/06